

REMARKS

This is in response to the Office Action mailed 12 February 2007.

Claims 1-5, 11, 12, 16, 17, 19 and 15-18 stand rejected under 35 U.S.C. 103(a) as unpatentable over applicant's submission of prior art (ASPA) in view of McCall (U.S. Patent No. 6,322,667). The office action urges that it would have been obvious to modify ASPA by providing McCall's paper of 7.3 points and 98.1% opacity.

It would not have been obvious to use McCall's paper since the paper disclosed by McCall has a composition not suitable for tickets. Also, even if such combination were achieved it would not be grounds for rejection since the claims assert an opacity of less than 98%.

Applicant's declaration under 37 CFR 1.132 is discussed in the office action wherein it is urged that the declaration is not persuasive because "there is no evidence that if a person skilled in the art, who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem."

Applicant's declaration under 37 CFR 1.132 filed 15 May 2006 explains, in part, that

I have reviewed U.S. Patent No. 6,332,667 to McCall et al. and observe that McCall et al. is directed to making linerboard and using old corrugated containers (OCC). Paper manufactured by the process described by McCall et al. is not suited for making tickets because, as described in McCall et al., the process uses fillers (ash, etc.) which are not well suited for use in tickets. For at least these reasons, one of ordinary skill in the ticket making industry would not have tried to use paper from McCall et al.'s process to make tickets.

Applicant's declaration is evidence that McCall's paper would not be useful in making tickets having a caliper characteristic between 5 and 8 points and an opacity characteristic of less than 98% as recited in the present claims. For at least these reasons, McCall does not teach or suggest paper as recited in applicant's claim 1 and the alleged combination does not combine to arrive at the claimed invention.

Applicant's declaration goes on to state that

[t]he use of tickets being formed from a substrate having a caliper characteristic between 5 and 8 points as recited in claim 1 provides unexpected advantages. Such stock is can be used for tickets that will not jam in dispensing machines, cut peoples hands and wear at an acceptable rate. Such unexpected results establish the critical

importance of the discovery of using substrate of between 5 and 8 points for tickets.

Thus, applicant's declaration provides evidence of unexpected results resulting from tickets having a caliper characteristic between 5 and 8 points and an opacity characteristic of less than 98% as recited in the present claims. This evidence underscores that it would not have been obvious to combine ASPA and McCall such that the rejection of claims 1-5, 11, 12, 16, 17, 19 and 15-18 does not provide a proper prima facie case of obviousness.

The declaration is evidence that no one has ever successfully provided tickets formed from a substrate having a caliper characteristic between 5 and 8 points and an opacity characteristic of less than 98%. The combination of tickets having this caliper and opacity is novel over simply providing tickets of different caliper. The long felt need and unexpected results provide evidence that this combination was not obvious.

Claims 21, 24 and 27 stand rejected under 35 U.S.C. 103(a) as unpatentable over Barnes (U.S. Patent No. 4,270,774) in view of McCall. The office action urges that it would have been obvious to modify Barnes by providing McCall's paper. As noted above, it would not have been obvious to use McCall's paper to make tickets having a caliper characteristic between 5 and 8 points and an opacity characteristic of less than 98% since the paper disclosed by McCall has a composition not suitable for tickets.

Claim 23 stands rejected under 35 U.S.C. 103(a) as unpatentable over Barnes in view of McCall and Shoemaker (U.S. Patent No. 6,796,487). Claim 23 is dependent on claim 21 and avoids the prior art for at least the same reason as claim 21.

Claim 25 stands rejected under 35 U.S.C. 103(a) as unpatentable over Barnes in view of McCall and Greenaway (U.S. Patent No. 4,143,810). Claim 25 is dependent on claim 24 and avoids the prior art for at least the same reason as claim 24.

Claim 26 stands rejected under 35 U.S.C. 103(a) as unpatentable over Barnes in view of McCall and Horniak (U.S. Patent No. 5,211,093). Claim 26 is dependent on claim 24 and avoids the prior art for at least the same reason as claim 24.

Claims 28-30 stand rejected under 35 U.S.C. 103(a) as unpatentable over applicant's submission of prior art (ASPA) in view of McCall and Wagle (U.S. Patent No. 4,919,758). Wagle is relied on for adding starch to enhance stiffness and opacity. Wagle is not cited for and does not make up for the above-noted deficiencies in the combination of ASPA and McCall et al.

Accordingly, on this basis withdrawal of the rejection of claims 28-30 is warranted and is, respectfully, solicited.

It would not have been obvious to modify ASPA and McCall et al by using starch as taught by Wagle because there is no teaching or suggestion of adding starch to tickets being formed from a paper substrate having a caliper characteristic between 5 and 8 points and an opacity characteristic of less than 98% since one of ordinary skill in the art would recognize that the addition of starch could harmfully effect the desired result, i.e., a ticket having a caliper characteristic between 5 and 8 points and an opacity characteristic of less than 98%. Accordingly, on this basis withdrawal of the rejection of claims 28-30 is warranted and is, respectfully, solicited.

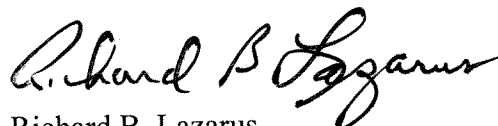
In view of the above, it is submitted that all of the pending non-withdrawn claims are in condition for allowance and such action is, respectfully, requested.

If there is any issue remaining to be resolved, the examiner is invited to telephone the undersigned so that resolution can be promptly effected.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and that shortages in fees, if any, be charged, or any overpayment in fees credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 (35481-73372).

Respectfully submitted,

BARNES & THORNBURG LLP

A handwritten signature in black ink, appearing to read "Richard B. Lazarus", written in a cursive style.

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